

**REMARKS**

Applicant notes with appreciation that the previous 35 USC 112 rejections of Claims 3 and 4 and the 25 USC 103 rejections over Iguchi and Konzer were overcome by Applicant's prior response. In the present response, Applicant has addressed the new 35 USC 112 rejections and 35 USC 102 and 103 rejections over Lovell.

**1. Claims Amendments.**

Applicant has amended the claims to address the examiner's concerns under 35 USC 112 and 101. Specifically:

Office Action Paragraph 6: Applicant has defined "pigment and filler" in the specification as originally filed. See Table 1; page 5, line 14; and page 6, lines 17-22. However, Applicant notes that the examiner's confusion may have arisen from Claims 6 and 16 and has amended "filler" to be "pigment and filler" for clarity. No new matter has been added. Applicant submits that the description of "pigment and filler" in the specification is sufficient to enable those of ordinary skill in the art to practice the invention as the satisfactory pigments and fillers can be used interchangeably in the field of this invention. Thus, the term "pigment and filler" recited in Claims 8, 9, 11, 18, 19, and 21 is not indefinite.

Applicant has defined "weight percent based on the weight of solids in the paint mixture" in the specification as originally filed. See page 6, lines 1-5: "The water soluble polymer can be added to the paint mixture at ratios of 1 to 30 weight percent based on the weight of the solids in the paint. For example, if a paint formula was 60 weight percent solids, there would be 0.6 to 18 parts of water soluble polymer for each 100 parts of paint mixture (60 parts of paint solids). The preferred ratio would be 2 to 10 weight percent of the water soluble polymer." Applicant submits that this description is sufficient to enable those of ordinary skill in the art to practice the invention. Thus, the term "weight percent based on the weight of solids in the paint mixture" recited in Claims 13, 18, and 23 is not unclear.

Applicant has amended Claims 1, 9, 14 and 19 to clarify that the claims are for a coating formulation that is applied to a substrate and the overall formulation accepts the

coloring without unacceptable running or bleeding. No new matter has been added. Applicant submits that this claim, along with the support of the specification as originally filed, is sufficient to enable those of ordinary skill in the art to practice the invention. Thus, the term limitation regarding "without unacceptable running or bleeding" recited in Claims 1, 9, 14, and 19 is clear.

Office Action Paragraph 7: Initially, all of the claims in the patent application are product claims and therefore do not need any process step and therefore satisfy the use requirement of 35 USC 101. However, even though the Applicant believes the claims are clear on their faces, Applicant has amended Claims 1, 9, 14, and 19 to include the recitation that the coating is applied to the substrate to bridge the gap between the recitation of the formulation for the coating and the recitation that the combination of the coating and the substrate is a coated substrate. Support for this clarification can be found in the specification as originally filed. See page 6, lines 6-7.

**2. The Claims Are Not Anticipated By Or Obvious In View Of US Patent No. 5629073 To Lovell**

Claims 1-12, 14-17, and 19-22 have been rejected under 35 USC 102 as anticipated by US Patent No. 5629073 to Lovell (Lovell '073), and Claims 13, 18, and 23 have been rejected under 35 USC 103 as obvious in view of Lovell '073. As Lovell '073 is the only patent cited, Applicant will address both rejections together.

Anticipation under 35 USC 102(b) requires "the disclosure in a prior art reference each and every element of the claimed invention." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *see also verdegall Bros. V. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The absence of one element from the cited prior reference negates anticipation. *See Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ2d 409 (Fed Cir. 1984). As discussed below, Lovell '073 does not contain each and every element as set forth in the current claims. Lovell '073 discloses and claims an electrically resistant article, and specifically

includes in the claim **both** the requirement of the coating having **conductive-resistance and a graphite**. The present invention discloses and claims *neither*.

The federal circuit has applied anticipation narrowly. For example, the Federal Circuit affirmed a district court determination that patents related to a ceramic welding process for repairing industrial furnaces were not invalid for anticipation, notwithstanding that the claims of the patents overlapped with or read on either or both of two prior art patents, because the district court properly determined that the prior art patents were related to flame-spraying and to combustion at the furnace wall. See *Glaverbel Societe Anonyme And Fosbel, Inc. v. Northlake Marketing & Supply, Inc.*, 33 USPQ2d 1496 (Fed Cir. 1995). Even though both inventions had a general relation to combustion, they were not so related that one of ordinary skill in the ceramic welding art would look to the flame-spraying art or the furnace wall combustion art. To the contrary, the only similarity between Lovell '073 and the present invention is the generic class 428 for "stock material or miscellaneous articles", which covers goods ranging from liquid crystal displays to religious artifacts and is not enough to support a finding of anticipation.

Next, for a claim to be determined obvious (or nonobvious) under 35 USC 103, the claimed material must have been obvious to person of ordinary skill in the art from the prior art. An obviousness determination requires examining (1) the scope of the prior art, (2) the level of skill in the art, and (3) the differences between the prior art and Applicant's invention. *Litton Systems, Inc. v. Honeywell, Inc.*, 117 SCt 1270 (1970). A mere suggestion to further experiment with disclosed principles would not render obvious an invention based on those principles. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991). In fact, an applicant may use a reference as his basis for further experimentation and to create his invention. *Id.*

The fact that each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. See *Custom Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The prior art must not be given an overly broad reading, but should be read in the context of the patent specifications and **as intended by reference authors**. *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that

district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard). The context of Lovell '073 is significantly different than the context of the present Invention and even a broad interpretation of the Lovell '073 claims would not read on or be considered related in any way to the claims of the present patent application by those of ordinary skill in the art in the relevant fields.

The Federal Circuit has defined and determined the bounds of the prior art to be identical for both nonobviousness and anticipation purposes. *See In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). Prior art for these purposes is pertinent art recognized by persons of ordinary skill to be in the *field of the invention*. *See In re Spada* 15 USPQ2d 1655, 1657 (Fed.Cir.1990), *In re Home*, 203 USPQ 969, 971 (CCPA 1979). Prior art is pertinent if persons of ordinary skill in the art would have consulted art in that field to develop the invention given the nature of the problem. *See In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). Specifically, the pertinence of any reference is dependent upon whether it would suggest to persons skilled in the art to do the thing that the applicant has done, and the same is true in considering more than one reference or a reference alleged not to be in the particular art. *See In re Phipps*, 69 USPQ 88 (CCPA 1946). Nonanalogous prior art cannot properly be considered prior art under 35 USC 103. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981).

***Lovell '073 is nonanalogous prior art relative to the present invention and cannot be considered as an anticipatory or obviating reference.*** As defined by the Lovell '073 patent itself, the Lovell '073 invention is a medium temperature conductive-resistive coating composition for proving temperature adjustment capability to a substrate. The present invention as defined in the specification is a flexible coated material for use as a medium for watercolor and inkjet printing using water-based inks, in which the coating accepts water-based colorants without unacceptable running or bleeding of the colorants and the coating allows for the removal of the colorants from the coating without harming the coating by wetting the coating and wiping off the colorants. Thus, Lovell '073 is nonanalogous art and cannot be used to anticipate or obviate the present invention.

To sustain a rejection under 35 USC 103, the examiner must establish a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. This just is not the case with the present invention. As the present invention is not fairly taught by or related to the subject matter of the cited prior art, it cannot and does not make obvious the present invention as claimed, and Applicant requests that this ground for rejection be withdrawn.

Initially, Lovell '073 and the present invention are for entirely different types of coatings used for entirely different purposes. Lovell '073 discloses a medium temperature conductive-resistive article employing graphite suspended in a high temperature polymer based activator and water that can be applied to a fabric-like substrate in order to provide an electrical resistive temperature adjustable heating element which can alter the temperature of the fabric-like substrate when electrical current is permitted to flow through the conductive-resistive substance, and claims an electrical resistant temperature adjustable article, which comprises a first substrate and a medium temperature conductive-resistive coating applied to said substrate, said medium temperature conductive-resistive coating comprising 10-30 weight percent graphite having a particle size from about 150 to about 325 mesh, 20-65 weight percent polymer latex and 6 to 60 weight percent total water based on 100 weight percent total composition, wherein said article is capable of having its temperature adjusted between ambient temperature and 400°F, and a method of providing temperature-adjustment capability to a substrate comprising applying a coating of a medium temperature conductive-resistive substance to said substrate, said medium-temperature conductive-resistive substance comprising 10-30 weight percent graphite having a particle size from about 150 to about 325 mesh, 20-65 weight percent polymer latex and 6 to 60 weight percent total water based on 100 weight percent total composition, wherein said article is capable of temperature adjustment between ambient temperature and 400°F.

The present patent application discloses a flexible coated material that can be used as a medium for watercolor and related techniques and methods and also are suitable for inkjet printing using water-based inks, and covers both woven and non-woven materials comprising a coating formulated to properly accept watercolor paints,

watercolor pencils, acrylic paints and water-based inks applied by inkjet printers, and also may be suitable for painting with oils and for drawing with pastels and pencils, and claims a coated substrate suitable for accepting water-based paints, pencils, and inks, comprising a substrate and a coating on the substrate, wherein (a) the coating has a formulation that accepts water-based paints, pencils, and inks without unacceptable running or bleeding of the water-based paints, pencils, and inks in and on the coating, (b) the coating is applied to the substrate, and (c) the formulation of the coating allows for the removal of the water-based paints, pencils, and inks from the coating without harming the coating by wetting the coating and wiping off the water-based paints, pencils, and inks.

The two inventions could not be more different, and those of ordinary skill in the conductive-resistance field would not look to the artists' canvas field for inspiration and vice versa. Even more to the point, Lovell '073 requires conductive resistance in the claims, while the present invention makes no mention of such a property either in the claims or in the specification. Due to the vast distinctions between the Lovell '073 coating and the present invention, Applicant assumes that the examiner's comparison may have resulted from the requirement of graphite in Lovell '073 and the option of using carbon black in the present invention. Initially, Lovell '073 *requires* the use of graphite as an active ingredient, while the present invention *only suggests* a use of carbon black as a filler or pigment, but for not for any active purpose. While it may be attractive to compare graphite with carbon black, graphite is a soft, hexagonal *crystal* allotrope of carbon with a greasy feel, often used in pencils and lubricants, but also can be fabricated into electrodes and rocket nozzles. Carbon black, to the contrary, is a finely divided form of *amorphous* carbon derived from the incomplete combustion of natural gas or petroleum oil and often is used as an ingredient in inks, paints, crayons, and polishes. So, while one, graphite, is used in many industrial applications, the other, carbon black, is used as a colorant, and the two cannot be interchanged.

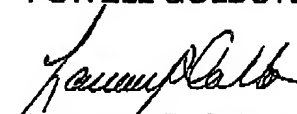
Thus, due to the differences in the inventions, the differences in the fields of use, the differences in the requirements of the claims, Lovell '073 neither anticipates nor obviates the present invention as claimed, and Applicant respectfully requests that this grounds for rejection be withdrawn.

**CONCLUSION**

Applicant submits that the patent application is in proper condition for allowance, and respectfully requests such action.

If the Commissioner or the Examiner has any questions that can be resolved over the telephone, please contact the below signed patent attorney of record.

Respectfully submitted,  
POWELL GOLDSTEIN LLP



Laurence P. Colton  
Reg. No. 33,371

POWELL GOLDSTEIN LLP  
1201 West Peachtree Street NW  
14<sup>th</sup> Floor  
Atlanta GA 30309-3488

Tel: 404.572.6710  
Fax: 404.572.6999  
E-Mail: lcolton@pogolaw.com